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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/318,353	05/25/1999	CHARLES L. CASAGRANDE	38916/14140	1317

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EXAMINER
HENDERSON, MARK T

ART UNIT	PAPER NUMBER
3722	20

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/318,353	CASAGRANDE, CHARLES L.	
Examiner	Art Unit	3722	
Mark T Henderson			

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 05 May 2003.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 13-16, 19, 20, 23 and 26-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) 13-16, 19, 20, 23 and 26-28 is/are allowed.
- 6) Claim(s) 29-40 and 44 is/are rejected.
- 7) Claim(s) 41-43 is/are objected to.
- 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_ is: a) approved b) disapproved by the Examiner.
- 12) If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \*    c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

<ol style="list-style-type: none"> <li>1)<input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</li> <li>2)<input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</li> <li>3)<input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.</li> </ol>	<ol style="list-style-type: none"> <li>4)<input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.</li> <li>5)<input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</li> <li>6)<input type="checkbox"/> Other: ____.</li> </ol>
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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1-10, 12, 17, 18, 21, 22, 25 have been canceled. Claims 13, 14, 15, 16, 19, 23, and 26-44 have been amended for further examination.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 29-32, 34, 36, 37-40 and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 34, 35, 40-42, 50-55, 57-61, 63 and 64 of copending Application No. 09/949,401 (Casagrande). Although the conflicting claims are not identical, they are not patentably distinct from each other because both Casagrande and Casagrande ('401) disclose a form comprising: a form layer having top and bottom surfaces and a perimeter; at least one die cut through the top and bottom surfaces within the perimeter of the form layer defining at least one form layer portion within the die-cut; a patch layer having a perimeter, top and bottom surfaces; a repositionable and peelable adhesive layer,

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wherein the adhesive layer has a greater affinity for the top surface of the patch layer than the bottom surface of the form layer portion.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 29, 30, 34, 40 and 44 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi.

Aoyagi discloses in Fig. 2 and 3, a form comprising: a patch layer (21) having a peripheral edge (D) extending around the patch layer, top surfaces (F), and bottom surface (G); an adhesive layer (22) having opposite top surface (A) and bottom surface (B) and a peripheral edge (C) extending around the adhesive layer (22), wherein the adhesive layer top surface is secured to the patch layer bottom surface and wherein both edges of the patch and adhesive layer coincide; a form layer (23) having a opposite top surfaces (L) and bottom surfaces (M) a peripheral edge (N)

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extending around the form layer, the form layer peripheral edge (N) being larger than the patch layer peripheral edge (seen in Fig. 2); the form layer top surface (L) being removably attached to the adhesive layer bottom surface (B) whereby the patch layer (21) is removably attached to the form layer top surface (L) in a position where a portion (X, as seen in Fig. 3) is exposed outside the patch layer peripheral edge (D); at least one die cut (25) through the top and bottom surfaces the periphery of the form layer inwardly space form peripheral edges of the adhesive layer and patch layer (as seen in Fig. 2) defining at least one form layer portion (23a and 23b); and wherein the adhesive layer (22) has a greater affinity for the bottom surface of the patch layer than the top surface of the form layer, whereby the patch layer and adhesive layer can be removed from the form layer top surface with the one form layer portion (23a and 23b) attached to the adhesive layer bottom surface to form a self-adhesive label; a second die cut (25a) through the form layer top and bottom surface within the peripheral edges of the patch layer and adhesive layer, and within the first die cut, wherein the second die cut defines a second form layer portion (23b) within the second die cut.

However, Aoyagi does not disclose a transparent patch layer

In regards to **Claim 29**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the patch layer out of any desirable material including transparent material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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4. Claim 33 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi in view of Jameson (4,910,058).

Aoyagi discloses a form comprising all the elements as claimed in Claim 29, and as set forth above. However, Aoyagi does not disclose a patch layer continuous within the patch layer peripheral edge with there being no die cuts through the patch layer.

Jameson discloses in Fig. 4-6, a form comprising a continuous patch layer (14) with no die cuts through the patch layer.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Aoyagi's form and replace the die cut patch layer with a continuous patch layer as taught by Jameson for the purpose of providing a carrier sheet which can support additional labels on its upper surface.

5. Claims 35-39 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Aoyagi in view of Popat et al.

Aoyagi discloses in Fig. 2 and 3, a form comprising all the elements as claimed in Claim 29, and as set forth above.

However, Aoyagi does not disclose: wherein the patch layer portion, the adhesive layer and the one attached form layer portion comprise a fold-over card; wherein the patch layer has an area twice as large as the one form layer portion; a fold line extending across the patch layer and the form layer portion being positioned entirely on one side of the fold line, wherein the fold line

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divides the patch layer into tow equal area sections; and wherein the fold line is a line perforations.

Popat et al discloses in Fig. 4 and 7, a form comprising: wherein a patch layer (80), the adhesive layer (58) and the one attached form layer portion (60) together comprise a fold-over card; wherein the patch layer (80) has an area twice as large as the one form layer portion (60); a perforated fold line (82) extending across the patch layer (80) and the form layer portion (60) being positioned entirely on one side of the fold line (as seen in Fig. 4), and wherein the fold line divides the patch layer into two equal area sections (52a and 52 b, as seen in Fig. 7).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Aoyagi's form to include a patch layer having an area twice as large than the attached form layer portion, a perforated fold line, wherein the form layer portion is positioned entirely on one side of the fold line, as taught by Popat et al for the purpose of forming a folded laminated card.

***Allowable Subject Matter***

6. Claims 13-16, 19, 20, 23 and 26-28 are allowed.

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7. The following is a statement of reasons for the indication of allowable subject matter: No prior art of record discloses a form with an integrated card comprising a form layer, a patch layer, a die cut through the top and bottom surfaces of the form layer to define a form layer portion, a layer of repositionable adhesive, wherein the patch layer, adhesive layer, and form layer portion together comprise a fold-over card intermediate; and a second die cut in the form layer defining a second form layer portion, wherein the second portion is disposed beneath the second half of the patch layer, such that the second form layer portion is secured to the bottom surface of the second half of the patch layer by the adhesive layer and becomes part of the fold-over card intermediate; and including all of the other limitations of the independent claim.

8. Claims 41-43 are finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 13-16, 19, 20, 23, 26-44 have been considered but are moot in view of the new ground(s) of rejection.

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*Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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### Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

*mth*

MTH

July 16, 2003

*A. L. Wellington*

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